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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/960,665	09/21/2001	Neal Rosen	MSK.P-038-2	5586

21121 7590 10/11/2002
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EXAMINER

KIFLE, BRUCK

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 10/11/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/960,665

Applicant(s)
Osen et al.

Examiner
Bruck Kifle, Ph.D.

Art Unit
1624



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Sep 16, 2002
- 2a) ☐ This action is FINAL.
- 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 6, 7, and 12-35 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 6, 7, and 12-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some* c) ☐ None of:

- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____.
- ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 3 and 4
- ☐ Interview Summary (PTO-413) Paper No(s). _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other:

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Applicant's amendments and remarks filed 9/25/02 have been received and reviewed.

Claims 1, 2, 6, 7 and 12-35 are now pending in this application.

Election/Restriction

Applicant's election of the compound wherein both the first and second hsp-binding moieties are geldanamycin and the linker is four carbons long in Paper No. 6 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

The elected compound was not found and the search was expanded to embrace geldanamycin dimers.

Claim Rejections - 35 USC § 112

Claims 1, 2, 6, 7 and 12-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- i) It is unclear where on the geldanamycins the linker is bonded to. Is it on the same position on each geldanamycin or can it be bonded at different locations on each?
- ii) The nature of the linker is not known. Is only an alkylene chain intended or could it also be other groups or atoms? It is unclear what the substituents are on the substituted carbon chain of the linker. Can the substituent be yet another geldanamycin?

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iii) In claim 12 and 26-30, it is unclear as to where these cells are that are to be destroyed. It is unclear which cells are expressing a HER-family tyrosine kinase and which ones are not. The claim also embraces cells in a petri dish. It is unclear what is accomplished.

Claims 13-17 and 31-35 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. These claims are drawn to the treatment of cancer. The specification does not provide enablement for the treatment of cancer generally. No compound has ever been found that can treat cancers generally even though massive efforts have been directed towards this end. Since this assertion is contrary to what is known in oncology, proof must be provided that this revolutionary assertion has merits. Nearly all anticancer drugs are effective against only a limited group of related cancers. Therefore, a compound effective against cancer generally would be a revolutionary exception. Applicant is asserting that he succeeded where others have failed. Where extensive efforts have all failed, it is reasonable for the Patent and Trademark Office to require proof that the claimed invention actually works for this specific utility. It is well established that a utility rejection is proper when scope of enablement is not reasonably correlated to the scope of the claims. (In re Vaec 20 USPQ2d 1439, 1444, In re Ferens 163 USPQ 609).

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In re Buting 163 USPQ 689 establishes that even clinical tests showing that a compound found to be useful in the treatment of two types of cancers was not sufficient for a much broader range.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruck Kifle whose telephone number is (703) 305-4484.

The fax phone number for this Group is (703) 308-4556 or (703) 305-3592. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

October 10, 2002


Bruck Kifle
Primary Examiner
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